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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,996	05/11/2006	Carsten Herpel	PD030116	5098
24498	7590	03/17/2009	EXAMINER	
Robert D. Shedd Thomson Licensing LLC PO Box 5312 PRINCETON, NJ 08543-5312			VU, THANH T	
			ART UNIT	PAPER NUMBER
			2175	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,996	Applicant(s) HERPEL ET AL.
	Examiner THANH T. VU	Art Unit 2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Objections

Claims 4-9 are objected to because of the following informalities: the preamble of claims 4-9 recite "method or device according to claim 1." However, claim 1 is a method claim, not a device claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "wherein the placeholder has at least one attribute associated". It is unclear whether the at least one attribute is associated with the placeholder or the at least one attribute is associated with some other elements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinallo et al. (US 5,929,857).

Per claim 1, Dinallo teaches a method for automatically composing an electronic audio-visual menu for selection of playback of audio-visual data, wherein a first portion of audio-visual data and a first portion of menu data is retrieved from a first storage medium being an exchangeable pre-recorded medium, and wherein a second portion of audio-visual data and a second portion of menu data are obtained from a second data source different from said first storage medium (fig. 1), wherein said second portion of menu data has at least one attribute associated, the method comprising the steps of:

generating an initial menu from the first portion of menu data, the initial menu containing one or more visible, selectable buttons and at least one invisible placeholder that cannot be selected, wherein the placeholder has at least one attribute associated (col. 9, lines 1-12 and 35-42, col. 10, lines 30-42);

extracting said attribute associated with the second portion of menu data (col. 7, lines 22-25 and lines 53-58; col. 9, lines 1-12);

comparing said extracted attribute with said attribute associated with the placeholder; and based on said comparison, if both attributes match, replacing the placeholder with a visible and selectable button defined by the second portion of menu data (col. 7, lines 40-45 and lines 54-60; col. 9, lines 44-51; col. 10, lines 31-42).

Per claim 2, Dinallo teaches method according to claim 1, further comprising the step of automatically detecting the availability of said second portion of menu data or of said second portion of audio-visual data (col. 7, lines 20-37; col. 10, lines 30-42).

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Claim 3 is rejected under the same rationale as claim 1.

Per claim 4, Dinallo teaches method or device according to claim 1, wherein the second data source is a local storage medium, and the data that defines the visible and selectable menu button replacing the placeholder contains a unique reference to the stored second portion of audio-visual data (fig. 1; storage medium 200 and 210).

Per claim 5, Dinallo teaches method or device according to claim 1, wherein the data that defines the visible and selectable button replacing the placeholder further contains button location information or a specification of conditions for button activation (col. 8, lines 18-41).

Per claim 6, Dinallo teaches method or device according to claim 1, wherein the data that defines the visible and selectable button replacing the placeholder further contains picture data defining the appearance of the button (col. 9, lines 40-51; col. 10, lines 30-42).

Per claim 7, Dinallo teaches method or device according to claim 1, wherein the exchangeable storage medium is rewritable, and said second portion of audio-visual data and said second portion of menu data are also stored on said medium (fig. 1; storage medium 200 and 210).

Per claim 8, Dinallo teaches method or device according to claim 1, wherein upon replacement of one or more placeholders by one or more visible and selectable buttons another, previously visible and selectable button defined in the first portion of menu data is disabled and switched invisible (col. 8, lines 29-31, lines 55-56; col. 9, lines 1-12 and lines 44-51).

Per claim 9, Dinallo teaches method or device according to claim 1, wherein said second portion of menu data contains navigation chaining information (col. 9, lines 44-52).

Claim 10 is rejected under the same rationale as claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yahata et al. (7,499,629) discloses recording medium, reproduction apparatus, recording method, program and reproduction method.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/

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Primary Examiner, Art Unit 2175